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In re Application of :  
JOHN, Edward Vines :  
Application No.: 10/559,590 : DECISION ON  
PCT No.: PCT/AU04/00707 :  
Int. Filing Date: 03 June 2004 : PETITION UNDER  
Priority Date: 03 June 2003 :  
Attorney Docket No.: 207,361 : 37 CFR 1.47(b)  
For: METHOD OF AND APPARATUS FOR :  
MAGNETIC THERAPY :

This is a decision on applicant's Petition Under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 18 August 2006. Applicant's submission has been treated as a Petition Under 37 CFR 1.47(b).

**BACKGROUND**

On 03 June 2004, applicant filed international application PCT/AU04/00707, claiming a priority date of 03 June 2003. A copy of the international application was transmitted to the Office on 09 December 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 03 December 2005.

On 09 September 2005, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, a petition to revive under 37 CFR 1.137(b).

On 21 March 2006, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 18 August 2006, applicant submitted this petition under 37 CFR 1.47 accompanied by the fee for a three month extension of time.

**DISCUSSION**

Applicants claim that this application has two joint inventors and that this application is being filed by the second joint inventor on behalf of both inventors. The international application lists only one inventor, Mr. Edward Vines John and the International Bureau has no record of the recording of a change under PCT Rule 92bis. 37 CFR 1.41(a)(4). As such, the sole inventor in this application is Edward Vines John. Applicant has not furnished a request under 37 CFR 1.497(d) to add an inventor nor has applicant furnished a petition to change the name or if this is the result of a typographical error, a request under MPEP 201.03 to correct the name of the first named inventor, who is referred to as John Edward Vines throughout the petition. A petition to prosecute the application when the sole inventor refuses to cooperate is a petition under 37 CFR 1.47(b), rather than a 37 CFR 1.47(a) petition.

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(g), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Items (1) and (6) have been met. (1) The balance of the \$200 petition fee will be charged to the deposit account no. 01-0035, as authorized. (6) Applicant has demonstrated that irreparable harm will result if the application is not permitted to proceed.

Item (2) has not been satisfied. Applicant claims that Mr. Vines is unstable and that presenting him with a copy of the application papers might put the presenter in jeopardy. Ordinarily, presentation with a complete copy of the application papers is done by mailing a complete copy, including the declaration to the last known address of the inventor by return receipt mail. The letter should give at least 14 days as a response time. Copies of documentary evidence indicating that the inventor received a complete copy of the application papers, including the signed mail receipt are then provided to the Office along with any response or a declaration attesting to the non-response after a reasonable period has passed. It is not required that someone from the corporation personally deliver the papers to the inventor. Further, if Mr. Vines is represented by counsel, the papers should be directed to Mr. Vines, through his counsel.

Item (3) has not been satisfied. Applicant states the last known mailing address of Mr. John Edward Vines as 12 Pago Terrace, Pacific Pines, Queensland 4211, Australia. However, the name of the non-signing inventor is "Edward Vines John," as indicated on the international application. A clarification or correction of the inventor's name is required.

Item (4) has not been satisfied. The declaration is not executed by the 37 CFR 1.47(b) applicant as set out in 37 CFR 1.497(b) and lists inventors who are not reflected in the international application. A petition under 37 CFR 1.497(d) has not been furnished nor has applicant attempted to correct the naming of the first named inventor.

Item (5) has not been satisfied. Applicant has not provided evidence of proprietary interest in the application. MPEP 409.03(f). Applicant has not provided an assignment or an employment agreement in which the inventor agreed to assign the invention to applicant. The "deed of assignment" is between two corporations and is for a priority application that is not identical to this application. In the absence of an assignment or an agreement to assign, applicant may establish a proprietary interest by an appropriate legal memorandum:

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United

States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record. *Id.*

**CONCLUSION**

For the above reasons, applicant's petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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